

## **REMARKS**

[0001] Claims 1, 3-5, 7-19, and 21-30 remain in the application. Claims 1, 16, 24, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 2004/0223663 in view of United States Patent No. 6,167,381 to Swaine *et al.* (hereinafter “Swaine”). Claim 3 stands rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

[0002] Claims 1, 8, 9, 16, 21, 23, 24, and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,609,223 to Iizaka *et al.* (hereinafter “Iizaka”) in view of Swaine. Claims 3, 4, 7, 10, 12, 17-18, 22, 25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iizaka and Swaine in view of U.S. Patent Number 5,497,314 issued to Novak (hereinafter “Novak”). Claims 5, 11, 19, 26, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iizaka and Swaine in view of U.S. Patent Number 6,366,696 issued to Hertz (hereinafter “Hertz”). Claims 13, 14, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Iizaka and Swaine in view of United States Patent No. 6,260,023 to Seevers (hereinafter “Seevers”).

[0003] Independent Claims 1, 9, 13, 16, 24, and 27 have been amended to clarify the novel aspects of the present invention. Dependent Claims 3, 4, 10, 14, 15, 18, 24, and 27 have been amended to clarify the subject matter claimed and to conform to other amendments.

## **RESPONSE TO REJECTIONS OF CLAIMS 1, 16, 24, AND 27 FOR DOUBLE PATENTING**

[0004] In the request for reconsideration filed January 3, 2006, the Applicants submitted a terminal disclaimer in response to the obvious-type double patenting rejection of Claims 1, 16, 24, and 27. Applicants submit that this terminal disclaimer overcomes the obvious-type double patenting rejection.

## **RESPONSE TO REJECTION OF CLAIM 3 UNDER 35 U.S.C. § 112**

[0005] Claim 3 stands rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. Applicants have amended Claim 3 to recite “the identity of

the item based on the visual characteristic captured for the item.” Support for this amendment is found in the specification on page 11, lines 22-27. In the present invention, the confirmation module may interact with a user and prompt the user for input confirming that the visual characteristic for the item does not contradict the identity determined using the coded identifier. Confirming such a potential contradiction with an user has the benefit of making the present invention more flexible. For example, bananas may have a green visual characteristic but the visual characteristic associated with the code identifier may be yellow. The confirmation module, with the limitations of Claim 3, permits such a discrepancy from generating a false fraud alarm. The Applicants respectfully assert that the amendment overcomes the rejection of Claim 3 under 35 U.S.C. § 112.

#### **RESPONSE TO REJECTION OF CLAIMS 1, 8, 9, 16, 21, 23, 24, AND 27 UNDER 35**

##### **U.S.C. § 103(a)**

[0006] The Examiner rejected claims 1, 8, 9, 16, 21, 23, 24, and 27 under 35 U.S.C. §103(a) as being unpatentable over Iizaka in view of Swaine.

[0007] It is well known that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP § 2142 under the heading “ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS.”

[0008] Applicants submit that in view of the current amendments, a case of obviousness under 35 U.S.C. §103(a) does not exist. Claim 1 is amended to clarify that the present invention includes a presentation module configured to present audio information “describing one or more visual characteristics of an item associated with the coded identifier.” Furthermore, this audio information is useful to a user for “detect[ing] a mismatch between the coded identifier and the item

to facilitate fraud detection.” Support for these amendments is found on page 15, lines 3-9 and lines 10-19 respectively.

[0009] Applicants submit that no case of obviousness exists because neither Iizaka nor Swaine teach audio information describing visual characteristics of an item associated with the coded identifier or use of this information to determine a fraudulent coded identifier. By way of example, a customer may attempt to defraud the retailer by attaching bar codes belonging to inexpensive items on expensive items. As the customer attempts to perform the fraud, the present invention reads the bar code and independently captures visual characteristics of the item. The present invention associates an item identify with the item using the database and the bar code. The present invention uses the color, size, shape, and/or texture of the item to verify the item identify. Finally, the present invention provides audio information describing one or more visual characteristics of an item associated with the coded identifier.

[0010] For example, suppose the item is a calculator with a bar code for a bright green package of gum attached. The presentation module may describe two visual characteristics of the gum associated with the bar code. The presentation module may verbalize “The scanned item should be a relatively small item with a bright green color.” If in fact, the item is a calculator 3-4 times the size of a package of gum and has a grey or black color, the operator/user of the checkout station is immediately alerted to the mismatch between the bar code and the visual characteristics of the scanned item. Consequently, the operator/user can take steps to defeat the fraud.

[0011] Iizaka teaches a checkout system with automatic registration of articles by bar code or by physical features of the article. Iizaka discloses a system that reads a bar code, decodes the bar code, derives feature data for the corresponding article from a database, and compares the feature data from the database with the feature data of the article. If there is no match in the database, the feature data of the article is registered into the database. *See* col 7, line 62 through col. 8, line 9. No differences between the feature data of the item and feature data of an item associated with the bar code is made. Unfortunately, this type of system will quickly lead to a corrupted database as unscrupulous customers attempt to defraud a retailer. The system taught by Iizaka will associate the feature data of the expensive article with the incorrect bar code and lead to greater fraud by

customers. As noted by the Examiner, Iizaka is **silent** regarding an apparatus or method of defeating this fraud.

[0012] Swaine, likewise discloses a checkout system. The system taught by Swaine is a self-service checkout system that includes a voice feedback device for providing audio feedback to the **customer** during the checkout procedure. An audible message is generated on the voice generating device which informs the customer of information associated with the item such as description and price. The voice generating device allows the customer to obtain information associated with each item without having to look at the display monitor. *See* col 4, lines 52-65.

[0013] There is no teaching or suggestion in Swaine or Iizaka that such a description include the visual characteristics associated with an item associated with the coded identifier. Instead, the description would be understood by one in the art to mean the common name or title of the item and not the visual characteristics of an item associated with a coded identifier. Often the description may be a generic class of goods such as electronics, household goods, batteries, soup, etc. Swaine fails to teach that the description includes visual characteristics of the item associated with the bar code.

[0014] Checkout stands are designed to handle very high volumes of customers in a very short time period. Often, the sales transaction, from start to finish, takes less than sixty seconds. In addition, attempts to defraud retailers continue to become more subtle. Thieves may avoid detection in Swaine by using false bar codes on items within the same class or type of goods. For example, generic-brand food bar codes may be affixed to name-brand products. Swaine would not uncover such a scheme. In contrast, the audio information of the claimed invention describes the visual characteristics of an item associated with the bar code. If the item is a Campbell's<sup>™</sup> soup product having a traditional red label, and the generic item for the bar code is generally blue, the audio information may verbalize that the item should be generally blue. Even though the checkout process proceeds at a fast pace, such a clear visual difference based on audio information enables a user or cashier to detect a mismatch between the scanned bar code and the actual item that is to be purchased.

[0015] Furthermore, Swaine teaches a self-service check out system. Providing voice feedback to the customer does little to prevent fraud when the customer is attempting to defraud a

retailer. Consequently, Swaine fails to detect and prevent fraud, even if Swaine taught that the audio description includes visual characteristics because Swaine teaches a self-service check out system.

[0016] The combination of Iizaka and Swaine, if possible, does not result in a system configured to defeat fraud, but rather may encourage greater fraud. The voice feedback device of Swaine coupled with the database population of Iizaka would result in a database full of false feature data. For example, a customer may swap bar codes and present the item to be scanned. The voice feedback device would then describe the item generically, and then register the false feature data with a wrong bar code in the database because a match is clearly not found. Such a combination, which ultimately corrupts the database and leads to greater fraud, obviously destroys the utility of both Iizaka and Swaine. Consequently, the combination of Iizaka and Swaine renders the claimed invention **nonobvious** because the Federal Circuit has determined that there is no suggestion or motivation to make a proposed modification if the modification would render the prior art unsatisfactory for its intended purpose. *See* MPEP § 2143 under the heading **The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose**.

[0017] Furthermore, in order to satisfy a case of obviousness, there must be a reasonable expectation of success. As described above, there would be no reasonable expectation of success because the combined Iizaka/Swaine system would perform horribly, requiring huge amounts of human intervention to repair the corrupted database every few days. Imagine a supermarket, or a home improvement center, each having inventories of 60,000+ items and attempting to discover which item has had its feature data registered improperly.

[0018] In addition, a case of obviousness requires a motivation to combine the references. In determining motivation to combine, it is impermissible to use the specification or disclosure provided by the Applicant as a “road map” to guide one from the teachings in Iizaka to the teachings in Swaine. Applicants submit that in view of the amendments, no express or implied suggestion or convincing line of reasoning exists as to why one skilled in the art at the time the invention was made would combine Iizaka and Swaine.

[0019] Therefore, the Applicants submit that the amendments to Claims 1, 9, 13, 16, 24, and 27 overcome the rejection under 35 U.S.C. § 103(a). Consequently, Applicants respectfully request

withdrawal of the rejection under 35 U.S.C. § 103(a) for dependent claims 8, 21, and 23 for depending from a nonobvious independent claim. *See* MPEP §2143.

**RESPONSE TO REJECTION OF CLAIMS 3, 4, 7, 10, 12, 17-18, 22, 25, AND 29 UNDER 35 U.S.C. § 103(a)**

[0020] The Examiner rejected claims 3, 4, 7, 10, 12, 17-18, 22, 25, and 29 as being unpatentable under 35 U.S.C. §103(a) over Iizaka/Swaine in view of Novak. Applicants respectfully submit that claims 3, 4, 7, 10, 12, 17-18, 22, and 29 are allowable for depending from nonobvious amended independent claims.

**RESPONSE TO REJECTION OF CLAIMS 5, 11, 19, 26, 28, AND 30 UNDER 35 U.S.C. § 103(a)**

[0021] The Examiner rejected claims 5, 11, 19, 26, 28, and 30 as being unpatentable under 35 U.S.C. §103(a) over Iizaka/Swaine in view of Hertz. Applicants respectfully submit that claims 5, 11, 19, 26, 28, and 30 are allowable for depending from nonobvious independent claims.

[0022] In addition, Claims 5, 11, 19, 26, and 30 highlight another distinction between the claimed invention and the prior art of record. Specifically, Claim 5 recites a “notification module configured to notify a user whether the coded identifier is associated with the item.” Claims 11, 19, 16, and 30 recite a similar limitation to that of Claim 5. Such notification is advantageous in retailer’s efforts to prevent fraud using coded identifiers.

[0023] For example, in the attended checkout system examples above, the cashier may not have to confront the customer about the fraud. Instead, the notification module may signal a security guard or management person who can come to the checkout and confront the customer about the fraud attempt. In this manner, the safety of the cashier is ensured and the fraud is still detected. Applicants submit that Iizaka, Swaine, and Hertz fail to teach a notification module that facilitates detection of fraud based on audio information as recited in the amended independent Claims

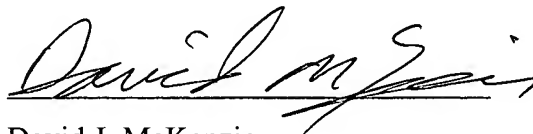
**RESPONSE TO REJECTION OF CLAIMS 13, 14, AND 15 UNDER 35 U.S.C. § 103(a)**

[0024] The Examiner rejected claims 13, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Iizaka/Swaine in view of Seevers. Applicant respectfully asserts that no case of obviousness exists because not all the elements recited in the amended claims are taught or suggested by the prior art.

[0025] Seevers teaches a system for processing transactions including a networked produce recognition system. As admitted by the Examiner, the combination of Iizaka/Swaine lacks a server. Seevers, furthermore, does not teach or disclose providing audio information “describing one or more visual characteristics of an item associated with the coded identifier.” As discussed above, the combination of Iizaka and Swaine destroys the utility of both systems, therefore rendering the combination unworkable. Applicants, therefore, respectfully assert that all of the claim limitations are not present, and furthermore there can be no motivation or suggestion to combine because the combination of Iizaka and Swaine destroys the utility of both. Applicants respectfully submit that Claims 13, 14, and 15 are allowable under 35 U.S.C. § 103(a).

[0026] Therefore, in view of the amendments made Applicants submit that Claims 1, 3-5, 7-19, and 21-30 are in condition for allowance. Should additional information be required regarding the traversal of the rejections of the dependent claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "David J. McKenzie", written over a horizontal line.

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